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| 09/749,036 | 12/28/2000 | Veronique Ferrari | 05725.0832-00 | 5474 |
| 22852 | 7590 | 11/23/2005 | EXAMINER | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | VENKAT, JYOTHSNA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1615 | |

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,036

Applicant(s)

FERRARI ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/29/05, 8/14/05

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt is acknowledged of amendment and IDS filed on 8/4/05 and 8/29/05. Claims 92-93, 97, 102-104, 113 and 115-120 are canceled.

Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221 and 223 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

The office action in the co-pending applications, which had a line-through has been considered but will not be listed for printing. The foreign documents that have been crossed-out have not been considered. The examiner considered the abstracts of these patents. The documents with respect to litigation have not been considered since these documents are not part of prior art.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 170, 172, 177-180, 183, 218-219, 221 and 223 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,783, 657 ('657); 3,148,125 ('125) and 6, 214, 329 ('329).

The instant application is claiming

1. Polymer of formula I
2. Pasty fatty substance
3. Oil or non-volatile oil (claims 143-144, and 147)
4. Volatile oil (claim 153)
5. Amphilic compound (claim 172)
6. Coloring agent (claims 178-180)
7. Wax (claim 183)
8. Additives (claim 177)

The patent '657 teaches polymer claimed in the instant application (ingredient 1) having gel consistency and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract; see cols. 3-4 and see col.3, line 24 where the patent teaches that these polymers are useful in eye-makeup. The eye make up products are Mascara, eye shadow and eyeliner. The patent suggests the usefulness of this polymer in the eye-make up art. The patent at col.17, lines 25-30 teaches that this polymer can be combined with water, colorants and fillers and also teaches adding volatile solvent. The difference between the patent

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and the instant application is the patent does not teach the volatile solvent or amphiphilic compound.

The patent '125 also teaches the polymer (Versamid) useful as lipsticks. See the explanation under 102(b). The patent '329 teaches Mascara product using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments and under example 1 teaches preservatives which are the parabens. The patent '329 teaches waxes at col.5, lines 15-37. The patent also teaches the combination of waxes, coloring agents, amphiphilic compounds, volatile and non volatile oils and using this combination with gelling agents

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions using the polymer of '657 or '125 and use it as Mascara or lipstick taught by both the patents along with oils, amphiphilic compounds, additives, oils, pigments, and use the specific volatile solvents and waxes of '329 expecting that the compositions are useful as Mascara or lipstick (cosmetics). The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and also when this polymer is combined with hydrocarbons (volatile solvent) it becomes transparent. This is prima facie case of obviousness.

Response to Arguments

4. Applicant's arguments filed 8/29/05 have been fully considered but they are not persuasive.

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5. Applicant's argue that Office has failed to demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify '657 and arrive at the present invention and applicant admit that patent '125 does disclose fatty acid esters and lanolin alcohols in a laundry list of optional ingredients, not all fatty acid esters, including several of the compounds listed in '125 as pasty fatty substances as defined by the instant claims and argue that even if one of the numerous compounds listed in '125 is a pasty fatty substance, the Office has not provided any specific motivation for one of ordinary skill in the art to choose any particular compound therein and add it to the compositions of '657.

6. In response to the above argument, patent '657 teaches ester-terminated polyamides in cosmetic formulations. The patent clearly teaches to one of ordinary skill in the art that the combination of the polyamides claimed along with liquid hydrocarbon (claimed as liquid fatty phase) forms clear transparent compositions having a gel consistency. The two properties of gel consistency and clear compositions are useful to the consumer. Patent '125 teaches the combination of polyamide resin which belongs to the genus of claimed polyamide resin, liquid fatty phase (castor oil) and pasty fatty substances (lanolin alcohols) provide clear lipsticks. Applicant's attention is drawn to examples. The patent at the paragraph bridging col.s 2 and 3 teach that the polyamide resin can be molded into stick and it can be made into crystal clear by combining with solvents like fatty acid esters. Applicants are claiming the same esters as one of the choices for "pasty fatty substances". Therefore both the patents teach that the combination of the polyamide resin whether the species claimed and disclosed in the patent '657 and the genus taught in the patent '125 forms crystal clear products. Patent '125 at col.3 teaches that the

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product can be made crystal clear, so that the color used in the lipstick is shown to advantage and without distortion, both in the stick and on the lips and it gives a depth and limpid color, which is extraordinarily attractive.

7. Applicants argue that patent '329 does not remedy the deficiencies set forth above, as it actually teaches away from the proposed combination, since patent '329 emphasizes throughout the disclosure that the composition includes a "non-polymeric gelling agent" where as the patents '657 and '125 teach polymeric gelling agent and patent '329 clearly teaches against by emphasizing non-polymeric gelling agents.

In response to the above argument, patent '329 teaches Mascara product (cosmetic) using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments and under example 1 teaches preservatives which are the parabens and teaches waxes at col.5, lines 15-37. The patent '329 is relied for the combination of waxes, coloring agents, amphilic compounds, volatile and non volatile oils and using this combination with compounds, which function as gelling agents. Therefore one of ordinary skill in the cosmetic art would use the specific oil of '329 and combine it with the compositions of '657 and '127 with the reasonable expectation of success that the incorporation of specific volatile oil into the compositions **would not destroy the gel property** since the same specific oil can be used with products having gel consistency. Therefore it is immaterial whether the gelling agent is polymeric or non-polymeric since the end result is having compositions with gel property and transparent property.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

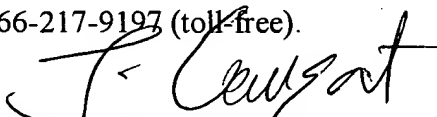
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D

JYOTHSNA VENKAT
PRIMARY EXAMINER
GROUP 1600-1602

Continuation of Disposition of Claims: Claims pending in the application are

121,122,124,127,129,131,132,137,143,144,147,153,157,158,161,166,169,170,172,177-180,183,218,219,221 and 223.

Continuation of Disposition of Claims: Claims rejected are

121,122,124,127,129,131,132,137,143,144,147,153,157,158,161,166,169,170,172,177-180,183,218,219,221 and 223.